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| 10/628,522 | 07/28/2003 | Wolfgang Neuberger | BJA311A | 5162 |

7590 10/18/2004
BOLESH J. SKUTNIK PhD, JD
515 Shaker Road
East Longmeadow, MA 01028

EXAMINER

SCHWARTZ, JORDAN MARC

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2873

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,522

Applicant(s)

NEUBERGER, WOLFGANG

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14 is/are allowed.
- 6) ☒ Claim(s) 1-4, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen patent number 6,059,775.

Nielsen reads on these claims by disclosing the limitations therein including the following: a safety contact lens (Figure 1, column 3, line 45); comprising means to protect an eye from harmful radiation (column 3, line 45); at least one identification area on the lens (Figures 2B-2D with the "identification area" as the masked portions located outside of an iris area that identify the portions of the lens that block the laser light); the identification area visible to third parties while the lens is worn on the eye (column 3, lines 13-33 with the masked areas being visible to the surgeon); and the identification area located outside of an area of the iris (Figure 2C embodiment and the portions of the Figures 2B and 2D embodiments that are masked and located outside of the iris area). Nielsen further discloses the harmful radiation as laser light (column 3, lines 13-47); the identification area as a shaded area (Figures 2B-2D); the identification area not overlaying the pupil of the eye (Figure 2C or Figure 2D with the outer masking ring as the "identification area"); and the identification area as

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a ring at or near a periphery of the lens (Figure 2D with the outer masking ring as the "identification area").

Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanome et al patent number 5,059,018.

Kanome et al reads on these claims by disclosing the limitations therein including the following: a safety contact lens (column 2, line 3); comprising means to protect an eye from harmful radiation (column 2, line 3); at least one identification area on the lens (column 1, line 41 to column 2, line 8, column 2, lines 60-65, column 4, line 51, Figures 1-5, 7-11 and 13 with the "identification area" as the marking on the lens); the identification area visible to third parties while the lens is worn on the eye (column 4, lines 51 and 63, re "another person cannot easily find it" so therefore it is visible to third parties though not easily visible); and the identification area located outside of the iris of the eye when the contact is lens worn (column 1, line 41 to column 2, line 8, column 2, lines 60-65, column 4, line 51, Figures 1-5, 7-11 and 13 with the "identification area" as the marking in the center of the lens or outer periphery of the lens). Kanome et al further discloses the harmful radiation as ultraviolet rays from the sun (column 2, line 3); the identification area as a tinted area or shaded area (column 1, line 50); and the identification area not overlaying the pupil of the eye (Figures 5 and 11 embodiments).

Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman patent number 5,617,154.

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Hoffman reads on these claims by disclosing the limitations therein including the following: a safety contact lens (abstract re contact lens and column 1, lines 5-20 and column 2, line 45 to column 3, line 5, absorbing ultraviolet light harmful to the eye re "safety"); comprising means to protect an eye from harmful radiation (column 1, lines 5-20 and column 2, line 45 to column 3, line 5); at least one identification area on the lens (column 2, line 11, column 15 lines 1-25 and examples 4-11, with the "identification area" as the coloring portion of the lens that is identifying the different color of the lens for filtering); the identification area visible to third parties while the lens is worn on the eye (examples 4-11, column 2, line 11, column 15, lines 1-25, with the different coloring of the lenses being visible to third parties); and the identification area located outside of the iris of the eye when the contact is lens worn (column 15, lines 1-25 with the portion of the tinting covering the pupil as "outside of an area of an iris"). Furthermore, Hoffman discloses that the entire lens can be tinted (column 2, line 11) and therefore, since the entire lens is being tinted, then any portion of the tinted lens not located over the iris can be considered as the "identification area" which will be visible to third parties since it is tinted and will be an "identification area" since it is identifying the different color of the lens. Hoffman further discloses the harmful radiation as ultraviolet rays from the sun (column 1, lines 5-20 and column 2, line 45 to column 3, line 5 i.e. the harmful radiation as a "high power optical source"); the identification area as a tinted area or shaded area (examples 4-11); and the identification area not overlaying the pupil of the eye (column 15, lines 4 and 18).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of Rawlings et al patent number 5,120,121.

Hoffman discloses as is set forth above including the shading area being provided by tinting (abstract) but does not disclose the claimed shaded area as an area of altered surface texture to increase opacity. Rawlings teaches that in a contact lens having a shaded area provided by tinting, that it is desirable to use an altered surface texture for the purpose of providing an improved cosmetic effect (column 10, lines 27-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the tinted contact lenses of Hoffman as further comprising an altered surface texture since Rawlings teaches that in a contact lens having a shaded area provided by tinting, that it is desirable to use an altered surface texture for the purpose of providing an improved cosmetic effect. Additionally, an increased textural pattern will inherently increase the opacity of the shaded area.

Allowable Subject Matter

Claims 5-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claims 11-14 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 5 and 11, none of the prior art either alone or in combination, disclose or teach of the claimed safety contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed color of the tinted area chosen to correspond to at least one radiation parameter to which the contact lens is protective according to a preselected scheme.

Specifically, with reference to claims 6-7 and 12-13, none of the prior art either alone or in combination, disclose or teach of the claimed safety contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed tinted area not visible under light in a normal visible range, and is only visible under light of a preselected wavelength range.

Specifically, with reference to claims 8 and 14, none of the prior art either alone or in combination, disclose or teach of the claimed safety contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed identification area having visual attributes that vary according to given radiation parameters with the visual attributes unique to a given treatment or set of radiation parameters according to a preselected scheme.

Response to Arguments

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Applicant's arguments filed July 23, 2004 have been considered but, with respect to the rejected claims by Hoffman and Nielson as set forth above, they are not persuasive. Specifically, with reference to Hoffman, applicant argues that the tinting area of Hoffman is used for filtering and does not have utility for identification purposes. However, applicant is broadly claiming "an identification area" and the colored portion of Hoffman would be identifying the portion of the lens used for filtering. Applicant further argues that the central tinted portion would not be easily recognizable to an outside person. Applicant, however, is claiming "visible to third persons" so therefore, whether it was easily visible to third persons or not easily visible, in either case it would be "visible to third persons". With respect to Nielsen, applicant argues that the Nielson shield only provides partial protection of the eye while the present invention provides complete protection to the entire exposed surface of the eye, however, applicant is arguing a limitation that has not been claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

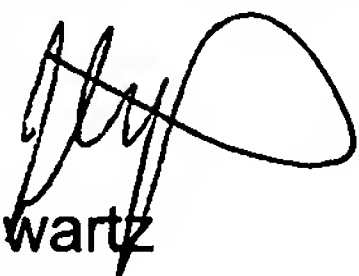
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jordan M. Schwartz

Primary Examiner

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October 13, 2004